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MAILSTOP: APPEAL BRIEF - PATENTS

IFW AF/1732

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Donald Arthur Reynolds
Appl. No. : 09/486,875
Filed : May 8, 2000
Title : GASKET FOR CLADDING SYSTEM
Grp./A.U. : 1732
Examiner : G. Shipsides
Docket No. : 65,008-018

TRANSMITTAL OF APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

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Dear Sir:

Applicant submits the attached Appeal Brief (1 original and 2 copies) in response to the Official Action dated February 17, 2004.

In addition the following fees are being provided for the filing of this enclosed Appeal Brief:

- A check for the enclosed Notice of Appeal in the amount of \$330.00
- A check for the enclosed Appeal Brief in the amount of \$ 330.00

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 08-2789. A duplicate copy of this letter is enclosed herewith.

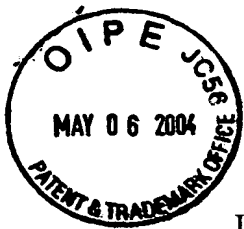
Respectfully submitted,

HOWARD & HOWARD ATTORNEYS, P.C.

May 3, 2004

Date

Harold W. Milton, Registration No. 22,180
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CERTIFICATE OF MAILING

I hereby certify that the attached Appeal Brief for application serial number **09/486,875** filed **May 8, 2000** is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to the **Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450** on this **May 3, 2004.**

Anne L. Kubit
Anne L. Kubit



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BRIEF ON APPEAL

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Applicant submits the following arguments in support of this appeal in response to the Final Rejection set forth in the Official Action dated **February 17, 2004**.

(1) Real Party in Interest

This application was assigned by the inventorship to **S D Investments Limited** as evidenced by the assignment recorded at reel **010818**, frame **0548**.

(2) Related Appeals and Interferences

NONE

(3) Status of Claims

Claims 1, 9, 11 and 12 are on appeal and are attached hereto in the appendix.

(4) Status of Amendments

An amendment is submitted herewith to correct the spelling of "resign " to –

resin--in line 7 of claim 1. It is assumed that amendment has been entered and is reflected in the claim 1 in the Appendix.

(5) Summary of Invention

As shown in Figure 4, a method of forming a joint between two plastic extrusions of solid material having front and rear surfaces comprising the steps of mitring the extrusions (10) at mitred ends (22) so that they form the desired angle to one another at a mitre joint across the entire extrusions (10). The method is distinguished by removing solid portions of the rear surface of each extrusion along a line (30) at the mitred ends behind the front surfaces (24) to maintain the integrity of the front surfaces at the mitred ends across the entire extrusion. The mitred extrusions are disposed in a mold to form a mitred joint with the front surfaces (24) abutting one another at the mitred joint to inject a plastic material (32) into the mold along the line (30) to rebuild the removed portion with a solid plastic material and bond the extrusions together across the mitred joint beneath the front surfaces (24) of the original mitred extrusions.

The entire inventive concept herein is to cut away the rear of a mitred joint beneath the front surfaces without cutting the front surfaces and injecting a resin to replace the cut away portion and bond the mitred corners together. The purpose of the invention is to produce "clean" corners without molding protrusions, differences in color or front surface texture, i.e., to preserve the features of the front surfaces of the mitred extrusions. It is important that the injected material defines a solid as distinguished from a hollow member.

(6) Issues

Whether claims 1, 9, 11 and 12 are not patentable over U. S. Patent 2,364,962 to

Eagles in view of U. S. Patent 3,958,369 to Mathellier.

(7) Grouping of Claims

Claims 1, 9, 11 and 12 are grouped together to stand of fall together.

(8) Argument

Eagles '962 discloses the cutting away of walls or partitions 20 and 21 in a hollow extrusion and thereafter inserting a preformed block 24. Mathellier ' 369 slices out a frontal section to present a frontal opening 17 and adds a front or corner piece 18 over the frontal opening 17. Neither reference responds to the limitations in the appealed claims of "removing solid portions of the rear surface of each extrusion along a line at the mitred ends behind the front surfaces . . . (emphasis added)." In the first instance, the subject invention relates to a solid extrusion as distinguished from the hollow tubes shown in the references. This is important since the rear of the mitred joint is removed along a line, that defines a plane, cut through the solid material, the solid material then being replaced by molding a solid shape along that line or plane, whereby the front surface of the joint is entirely defined by the front surfaces of the original mitred extrusions.

Applicant is not the first to mitre and connect such extrusions, but applicant has invented a specifically different method for joining such extrusions. Neither reference suggests applicant's method of cutting away only the solid back along a line and injecting material to rebuild the solid back behind the front surfaces to retain the integrity of the front surfaces. Eagles '962 teaches the removal of the innards (partitions) only of a hollow tube and the insertion of a block into the hollow tube. Mathellier '849 teaches the

removal of the front of a hollow tube and the attachment of an acute angled corner piece. Even if the references could be combined the claimed method would not result, i.e., cutting away only the solid back along a line and injecting material to rebuild the solid back behind the front surfaces to retain the integrity of the front surfaces.

There is no reason outside of applicant's teaching to modify either of the references.

The law is adequately set forth in the MPEP:

2143.03 All Claim Limitations Must Be Taught or Suggested [R-1]

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837, F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

2142 Legal Concept of *Prima Facie* Obviousness [R-1]

. . . The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness . . .

ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the

claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not be based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §243 - §2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references as suggested by the Examiner. In order for the rejection to stand there must be a reasonable expectation of success in the combination the examiner suggests. It is respectfully submitted that the Eagles '962 hollow strips could not be placed in a mold to receive injected plastic because the plastic would run freely down the hollow extrusions. That is why it is important that the extrusions be solid as set forth in the claims. Finally, the prior art references when combined do not teach or suggest all the claim limitations; to wit, the extrusions are not cut away along a line as claimed. In other words, in both of the references the cutting is along different lines or planes and in Mathellier '369 the slice is scalloped out. It is respectfully submitted that the teaching or suggestion to make the claimed combination and the reasonable expectation of success

are not both found in the prior art, but are based only on applicant's disclosure.

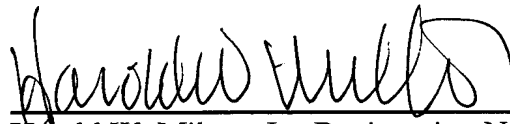
The reversal of the examiner's rejection under 35 U.S.C. 103 is respectfully solicited.

Respectfully submitted

HOWARD & HOWARD ATTORNEYS, P.C.

May 3, 2004

Date



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Anne L. Kubit

(9) Appendix

1. A method of forming a joint between two plastic extrusions having front and rear surfaces with solid material between said surfaces comprising; mitring the extrusions so they form the desired angle to one another at a mitre joint across the entire extrusions, removing a solid part of the rear face of each extrusion behind said front surfaces while maintaining the integrity of said front surface of each extrusion across the entire extrusion, placing the mitred extrusions in a mould and injecting a resin material to restore the solid shape and bond the extrusions to one another across the mitred joint beneath the front surfaces and produce the desired joint configuration whereby the front surface of the joint is entirely defined by the front surfaces of the original mitred extrusions.

9. A method of forming a joint between two plastic extrusions of solid material having front and rear surfaces comprising the steps of;

mitring the extrusions at mitred ends across the entire extrusions so that they form the desired angle to one another at the mitred ends,

removing solid portions of the rear surface of each extrusion along a line at the mitred ends behind the front surfaces to maintain the front surfaces across the entire extrusions to maintain the integrity of the front surfaces at the mitred ends across the entire extrusions,

placing the mitred extrusions in a mold to form a mitred joint with the front surfaces abutting one another at the mitred joint across the entirety of the original extrusions,

injecting a plastic material into the mold along the line to rebuild the removed portion entirely behind the front surfaces with a solid plastic material and bond the extrusions together across the mitred joint beneath the original front surfaces.

11. A method as set forth in claim 9 including at least one sealing lip on the rear surface and injecting the plastic material into the mold to form a continuation of the sealing lip between the extrusions.

12. A method as set forth in claim 9 including male foot portions for insertion into a channel to retain the extrusions to a structure and injecting the plastic material into the mold to form at least one extension of the foot portions.